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RECORD OF ORAL HEARING
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte PATRICK J. O'DONNELL

Appeal 2009-013836
Application 09/557,234
Technology Center 3600

Oral Hearing Held: September 14, 2011

Before ROBERT A. CLARKE, CHARLES N. GREENHUT, and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

GLENN NUTTALL, ESQUIRE
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, California 92614

The above-entitled matter came on for hearing Wednesday,
September 14, 2011, commencing at 1:45 p.m., at the U.S. Patent and
Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah
Courville, a Notary Public.

PROCEEDINGS

JUDGE CLARKE: Good afternoon, Mr. Nuttall. We've had a chance to look at this case beforehand and we're ready to hear your arguments concerning patentability, so go right ahead and you can start your arguments.

MR. NUTTALL: All right. Thank you very much, Your Honors. This case is not an earth shattering or even difficult structure. But the Applicant here has addressed an issue that I think is becoming more and more popular. The problem is that people have bugs on their landscape, and increasingly, people don't want to use chemicals to remove those bugs or other pests. So they've tried spraying them off in various ways and with various structures and without a whole lot of success because it's such a pain in the neck, quite frankly.

So what the Applicant did is kind of tweaked the structures that are already available and figured out a way to use them that was particularly effective and could blast these critters off the undersides of leaves and at the same time help blast those critters -- blast them off the leaves out of the plant by having streams that go up and down and to the side, all at the same time. And also, this can be used in various elevations and plants.

And if it's used a certain way, it can be very effective and not necessarily get the user completely soaked. If it's used in traditional ways of spraying plants, then it probably won't be all that effective, and you are going to get soaked. I can't attest to that one from my experience.

But the bottom line here is we have two independent method claims, non-structural claims. And the key to these method claims are the ability to have a nozzle with outwardly-directed spray and holding the nozzle in a generally 90-degree -- not 90-degree -- excuse me -- a horizontal attitude.

That way, the spray is directed up and down simultaneously, and you get a really effective operation. Now, when you want to change the elevation of this device, you rotate it so that you maintain that horizontal longitudinal axis of the nozzle end. And that way, you maintain the nozzle in its most effective orientation. And again, you insert it into the plant, take it out of the plant.

And in a nutshell, that's what these independent claims are about. Now, in the prior art, we have sprayers such as the Guo reference. This is pretty much a conventional-looking sprayer, and we really don't know much about it, as it's a design patent, but I think we've seen these in the hardware stores. They have an angle, angular bend near the distal end, but all the spray is generally in the same direction, and this particular structure wouldn't work for what the method requires. It wouldn't be possible to do the method with it.

The other reference that is combined is the Jet-all reference, which is a flyer for a -- it's a product that is used with roses. And I'm confident you have that in front of you there. The Jet-all has three distinct spray heads that generally go upward and outward. They're upward and distal from a bent head. And the way it's used, from what we can divine is that the user will spray away from them near the bottom of the rose bush and presumably draw it up the stalk to try and spray on any of these leaves. While a nice device for roses, I guess, it has problems in that it's not very versatile, you have to be very careful how you use it, and if you rotate it, it's not going to work as well.

So the Examiner has first of all indicated that Guo and Jet-all can be combined. And I don't know if that really adds a whole lot of structure --

that they have very similar structures except Jet-all has those sprayers -- excuse me -- upwardly-directed sprays. But as far as method goes, I don't believe that combining these teaches the recited method. Now, specifically, the requirement of holding the nozzle at a horizontal attitude and of -- then when you want to change altitude, you rotate the device, rotate the handle so that that nozzle is maintained at that horizontal attitude.

In the Examiner's paper, he uses the term inherently a lot. And what I'm taking from that is that she feels that somewhere along the line, if you use the Guo/Jet-all device, that somewhere it's going to -- the nozzle is going to be at a horizontal attitude. And I just don't think that satisfies the requirements for inherency. Inherency does require more certainty. The cases that I know I cited in the Appeal Brief on page 20, note 20 and 21, would find that there is not inherency if there isn't -- if the aspect isn't necessarily present in the reference.

For example, there was no inherency in Electro Medical Assistance v. Cooper Life Sciences because a particular water pressure wasn't explicitly disclosed in the prior art patent. And in In re: Rickert -- I think is how you say that -- there were certain settings that had to be assumed in order to achieve the conditions that were claimed for inherency. And the court said that, no, you can't make these assumptions and inherency doesn't come by chance. It has to be certain.

And if nothing else, I believe that the Examiner's arguments are somewhat of an admission that it's certainly not explicitly in the art. Nobody really knew about this method. And, in fact, this is unfamiliar to people. And when she's saying that somewhere along the lines somebody may have a nozzle that gets horizontal, I just don't think that teaches this method,

because certainly people aren't recognizing that this method exists. At least there is no record of it in the prior art. The other issue with the inherency is the cases that I was able to find all referred to inherency being on a single reference. And she has used it in a combination of references. And I just don't believe that's appropriate, quite frankly.

So moving on, then, Claim 36 was rejected on the combination of Guo and Jet-all, and Claim 19, the earlier independent claim, added to that combination the Arnold reference. Now, the Arnold reference is a sprayer, really a sprayer that sends out a sheet of water that looks to be about 90 degrees from the horizontal. My problem with that is that I just don't think there is a motivation to combine Arnold with something such as Guo. Guo is something that I think we're familiar with, and that is, it's for watering plants. And people use it to get access to plants and give them water. The nozzle is purposely one of those nozzles that isn't a high-pressure nozzle. It distributes the water and makes it better for watering plants without disturbing the dirt around the plants. Arnold is quite different. It's a high-pressure nozzle, and it is 90 degrees from the longitudinal axis.

So if somebody were to throw the Arnold nozzle onto a Guo device, they're really asking to spray themselves, and Guo is really no longer appropriate for watering plants. So I just do not see a motivation to add Arnold to Guo unless, of course, somebody has read our Applicant's specification, which would give a motivation, but that's really not the task.

JUDGE CLARKE: Mr. Nuttall?

MR. NUTTALL: Yes?

JUDGE CLARKE: This is Judge Clarke. Would you agree that the nozzles are both for distributing water and the result would be predictable,

that if you used the nozzle of Arnold, it would create a spray around the circumference?

MR. NUTTALL: Yes. I would agree that Arnold would create a spray around the circumference, to the extent I understand Arnold.

JUDGE CLARKE: Right.

MR. NUTTALL: Yeah.

JUDGE CLARKE: And that they are both nozzle heads?

MR. NUTTALL: Yes.

JUDGE CLARKE: Okay -- go ahead.

JUDGE HOELTER: This is Judge Hoelter. If I could direct your attention to Arnold, column 1, Arnold, column 1 talks about a nozzle that's adapted to eject a pair of radial sprays having a common axis. I'm on lines, like, 3, 4 -- 3 through 10, you might say.

MR. NUTTALL: Okay, yes.

JUDGE HOELTER: And that an object is to provide a nozzle of the above type, where the two radial sprays may be caused to produce a predetermined relationship, and they may extend to parallel planes, you know, the bottom of one leaf, the top of another leaf, or may diverge or converge, according to the requirements.

MR. NUTTALL: Right.

JUDGE HOELTER: So it seems to me that Arnold is indicating to spray -- to have a spray that's radial from the main axis of the nozzle with the purpose being to spray in two parallel planes. Would you address that in comparison to what is being claimed?

MR. NUTTALL: Sure. I'd be happy to. The device -- excuse me, the nozzle of Arnold, of course, is used in a washing device. I believe it's a

bottle-washing device. But the issue there is cleaning -- let's see -- yeah. So it does teach that structure of spraying around the longitudinal axis. Now, my issue isn't so much that I don't believe the client here, the Applicant here, has invented a nozzle with a continuous stream around the longitudinal axis. I think that's clearly out now already. What I think the client, the Applicant, has done here is found a way to use -- found a reason to put a nozzle such as Arnold onto a handle device with a bend in the handle, and a way to use it that is especially effective at cleaning bushes and these leaves without necessarily getting the user soaked.

JUDGE HOELTER: So the focus, then, if I understand you correctly, the crux of the Applicant's invention is the movement of the nozzle towards the plant stem and away from the plant stem?

MR. NUTTALL: It's nearly that. We may be on the same page there. But it's a little bit more detailed than that in that it needs to be able to hold that nozzle at a horizontal attitude and moving it in and out of the plant, but then rotating the entire device. It can't just be a nozzle. It has to be a nozzle on a device having a handle and an elongated body, to have a bend in between them, and being able to pull that nozzle out of the plant, rotate the entire handle and elongated body, or the entire apparatus, but rotate it in a way that the nozzle portion stays in a horizontal attitude and then can be put into the plant at another altitude and still be just as effective without necessarily soaking the user.

JUDGE GREENHUT: This is Judge Greenhut. Without the nozzle of Guo, could you use Guo to do that horizontal -- to do that 90-degree movement and then remain generally horizontally disposed?

MR. NUTTALL: Your Honor, I don't think so. With the way Guo is disclosed, you've got the -- just to clarify, you're considering using Guo alone, as disclosed, in accordance with the method that's claimed?

JUDGE GREENHUT: Well, I'm just -- I'm comparing what I see in Guo and what I see in the structure of your device in figure 1. And it looked -- except for the nozzle, they look similar enough that it seems like you could make that rotating movement. So I wanted to hear your thoughts on that.

MR. NUTTALL: And I'm sorry, Judge Greenhut. I kind of missed the end of your comment there.

JUDGE GREENHUT: I just wanted to hear your thoughts on using Guo to perform that rotation and whether, except for the nozzle portion, whether that's going to remain in that 90-degree -- in that horizontal plane during that 90-degree turn.

MR. NUTTALL: Well, as far as Guo goes, I believe you can use the Guo structure and move it 90 degrees, for example, while keeping the Guo nozzle in the longitudinal horizontal attitude if you make that effort. The problem with Guo is the nozzle. Guo's nozzle really is one of those that's directed -- will direct streams that are parallel to the longitudinal axis of the nozzle. And so while you can arrange Guo in the attitude, et cetera, that is claimed. The nozzle of Guo really isn't going to work, at least not well. It's not really going to do the job, quite frankly. But the structure of Guo's handle and the fact that there is a bend would make it possible for a user to follow the positioning portions of the method at least.

JUDGE GREENHUT: And that positioning could not be performed with the Jet-all reference?

MR. NUTTALL: The Jet-all reference, just the structure of the Jet-all reference is a lot harder to make that work. So in Guo, we've got that nice bend in between the handle and the nozzle. With Jet-all -- there is a picture of it -- it's got more of a complex bend, several different bends, and it's actually not clear to me how they would keep that horizontal. It seems more difficult. Perhaps it could be done. It very well could be done, but it's harder for me to see them accomplishing it. You've got all the bends and the curves, and such. It almost seems like if you look at the Jet-all brochure, there's the picture on the right with the lady holding the device. And she's got a handle with the bend, and then it's connected to the little Jet-all attachment, which is on the very end. And although there are bends, and such, it almost looks as if the end result is just a longer handle and that those bends are actually to get the tube out of the way of the higher leaves. And I'm just presuming that. So I don't think the Jet-all structure as it stands could really accomplish this even if it were used according to the method that's claimed.

JUDGE HOELTER: This is Judge Hoelter. The image that you have of Jet-all, I'm wondering if it's a little bit clearer than the image that we have here. Are you able to tell from your image whether the spray on Jet-all is a fan spray or whether it's a circular spray?

MR. NUTTALL: In generally, there are three small fan sprays, and each of them -- they take up about -- it looks like to be about 75 degrees of the top of the Jet-all space, of the Jet-all device. So there's three of them that act together to do that.

JUDGE HOELTER: Okay. So it's like a fan spray, then, of, say, the upper third of the --

MR. NUTTALL: Yeah.

JUDGE HOELTER: That's what it appears on our end, but I wanted to hear if you had a better view of it.

MR. NUTTALL: No, that's the same as I've got. I've got the black and white copy as well.

I think the crux here is that it's certainly not an earth-shattering structure. It's just that Pat O'Donnell, the landscaper who came up with this, he's figured out a way to just use water without any chemicals to clean the entire bush and to do it quickly with the high power sprays that go outwardly around, substantially, the entire circumference, and be able to do the entire plant. With Jet-all, you see the lady there. She seems to have to go up every single branch, which would just take so long. I doubt it would really get done.

With something of the claimed method, you could push it into your bush, or whatever, at one level, move it a little bit, keep it horizontal, put it back in and out and just do the in and out over and over again not having to be so precise about a particular stalk or particular branches. Since you are maintaining horizontal attitude and you're spraying all the way around, you can go in and out at all these different altitudes to clean the entire bush and both spray the bugs off the bottom of the leaves, and at the same time, the bugs that have been sprayed off, then fall down on the leaves below will -- the claimed method will spray those bugs on the leaves below off as well. But I guess you could say it's an easier, quicker, more effective way to do it, and it does have to tweak the structures that we're all used to --

JUDGE HOELTER: Okay, sir. This is Judge Hoelter again. I want to make sure I understand you. In Applicant's invention, you move the device in and out, and you have to do it at different heights of the plant?

MR. NUTTALL: Correct.

JUDGE HOELTER: So depending on the height of the plant, you may have to move it in and out multiple times?

MR. NUTTALL: Absolutely, yes.

JUDGE HOELTER: How does that differ from Jet-all again?

MR. NUTTALL: In Jet-all, they have the fan sprays at the top of the device. It's disclosed for roses, and what I can divine from the brochure that we have is that the user will take the general device up an individual stalk of the rose and hit the leaves that are in that particular stalk and move on to the next stalk and go up. So it's more of a one stalk at a time issue with the Jet-all device. Plus, Jet-all, you have to manually adjust to make sure you get each particular leaf. With the claimed device, you've got your circumferential spray. You're going horizontally in and out. You're going to clean the entire bush without having to pay attention to a particular stalk. Jet-all, you have to pay very close attention to what you've hit and what you haven't.

JUDGE HOELTER: And why is that?

MR. NUTTALL: Because you only have, for example, that one-third of a spray, for one. And for two, the way they teach of using it, of just taking up one stalk at a time and also of -- they don't teach keeping the nozzle horizontal, so you have to be careful which leaves you're spraying up on, which leaves you're spraying to the side on. One problem with Jet-all is that depending on where you are on the plant, if you're really low on the

plant, you have -- for example, in the picture with the lady, she's got the sprays that are almost horizontal. So that's really not going to be very effective for many of the leaves.

So with the claimed method, you've got the sprays that are going to be radially outward. So they're going to be directly upwardly and downwardly at the same time. You keep your nozzle horizontal, not the spray, and so you're going to have more thorough coverage. Jet-all, you're just not going to do that unless you use it in a way different than what they teach.

JUDGE HOELTER: But Arnold teaches that, though. Arnold teaches the radial spray on both planes.

MR. NUTTALL: Yeah, Arnold teaches a radial spray, yes, but it doesn't teach a way of using it or of connecting it to the handle that we have. Arnold would not teach you to connect it to Guo's handle. And Guo, if you put the Arnold handle on it, it would -- really, there is no teaching that would direct you to add Arnold to Guo, because Guo is for watering plants and Arnold is in a totally different direction than what Guo would teach. And even if you attached Arnold to Jet-all, they still wouldn't know how to use it. They would still be only teaching you how to use it the same way they used the Jet-all, which is that pull it up one branch at a time approach. And they also don't know how to orient it so that the sprays are directed in a way that works really well.

JUDGE CLARKE: Okay, Mr. Nuttall, I think we don't have any more questions for you. If you're done with your presentation, we'll consider the hearing concluded.

MR. NUTTALL: Okay. Well, I guess the final thought would be the claims here, we're really trying to keep them narrow to this particular

method. And it is something that the Applicant didn't discuss it with other people, and he entered into a -- not a competition, but a test with a local magazine -- not a local magazine -- nationwide magazine some years ago and submitted the device to people to use and got very positive results. And what was interesting in that test -- and we did submit his Declaration and some sample evaluations from his test. But one of the themes within the test was that people would spray themselves until they figured out how to use it. And for people to be able to know how to use this correctly -- and these are people that are really into gardening -- they had to follow the directions and be told, okay, keep it horizontal, take it in and out, rotate it, keep it horizontal. And there are comments along the lines of people saying, I got sprayed until I figured out how to use it right, and then it was great.

So what that says to me, and my argument associated with that, would be that people wouldn't do this just on their own. They need to be taught this method. Even though it seems simple, it is something that isn't inherent or obvious. And it works really well, but it's different than everything that's out there. And the structures that can be used for this method, while similar, looking to what, you know, is familiar to us, just have to be tweaked in order to be used in a way that people normally wouldn't use them. People wouldn't normally put a nozzle such as Arnold onto a watering wand such as Guo. That's just not a normal thing. But if you're taught how to use that in a particular way, along the lines of this method, then it becomes something that's very beneficial and does a good job.

JUDGE CLARKE: Okay. I think we understand your argument, and thank you for your appearance.

(Whereupon, the proceedings, at 2:14 p.m., were concluded.)